

**Remarks**

This paper is being filed in response to the Office Action mailed on 20 September 2005 in Reexamination Proceeding 90/006,090. A copy of this paper is also being filed in Reissue Application 10/626,486. These two proceedings were merged pursuant to the Decision mailed on 23 May 2005.

In this response, Applicant has not amended the claims, has not added any new claims, and has not cancelled any claims. Therefore, Claims 1–23 remain pending in this application. Claims 1 and 14 are independent. Claims 14, 15 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sher, *Surgery for Hyperopia & Presbyopia*, October 1997, Williams & Wilkens, First Edition, pages 33–36 (“Sher”). Claims 1–13, 16–21 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sher in view of U.S. Patent 5,489,299 (“Schachar”) and U.S. Patent 5,520,679 (“Lin”).

**Claim Rejections Under 35 U.S.C. § 103(a) based on Sher.**

Claims 14, 15 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sher. Claim 14 is independent, and Claims 15 and 22 depend from Claim 14.

The Examiner has acknowledged that Sher fails to disclose cutting “to a depth of 80–90% of the thickness of the scleral tissue”, as is recited in Claim 14. However, the Examiner has taken the position that cutting to this depth “would have been within the level of skill of the artisan to select to optimize the procedure”. While Applicant has pointed out that Sher explicitly discloses that making the incisions too deep may cause hemorrhage, the Examiner has taken the position that the disclosure of Sher “falls short of discouraging the skilled artisan from employing a depth of 80% to 90% of the scleral thickness”.

**1. The advantages obtained by using Applicant's claimed range of incision depths attest to the non-obviousness of that range.**

Performing a presbyopia treatment using the parameters recited in Claim 14 provides substantial benefits as compared to performing a presbyopia treatment using the parameters taught by Sher. Submitted with this Response is a Declaration by Jon Siems, M.D. under 37 C.F.R. § 1.132 ("the Siems Declaration") presenting evidence supporting this position. In particular, the Siems Declaration indicates that if incisions are made to the depth taught by Sher, significant regression occurs after the treatment is performed, thus leaving the patient with little or no clinical benefit from the procedure. The Siems Declaration further indicates that if incisions are made to a depth greater than or equal to about 80% of the scleral thickness, little or no regression occurs, thus providing the patient with a substantial clinical benefit from the procedure. Thus, substantial advantages result from use of Applicant's claimed range of incision depths. These substantial advantages attest to the non-obviousness of the claimed range, and thus Applicant respectfully submits that Claims 14, 15 and 22 are not obvious in view of the Sher reference. The features of dependent Claims 15 and 22 are believed to be patentable in combination with those of their respective independent claims.

**2. The Applicant's claimed range of incision depths is contrary to accepted wisdom, as taught by the prior art.**

Proceeding contrary to accepted wisdom in the art is strong evidence of unobviousness. *In re Hedges*, 783 F.2d 1038, 1041 (Fed. Cir. 1986). In *Hedges*, Hedges claimed a reaction occurring at greater than 127°C, while the teachings of the prior art ("Mark") disclosed that (a) the reaction could be carried out at room temperature or at an elevated temperature, such as about 50°C, and (b) lower temperatures were needed for optimum results in the given reaction. *Id.* at 1039-41. The Federal Circuit found Hedges's claim to be nonobvious in view of these prior art teachings.

The facts of the instant case are directly analogous to the facts of *Hedges*. Applicant has claimed cutting "to a depth of 80-90% of the thickness of the scleral tissue". Sher teaches that (a) the preferred incision depth is between 65% and 70% of

the scleral thickness, and (b) that if the incision is too deep, hemorrhaging may occur. Thus, just as Hedges proceeded contrary to accepted wisdom by conducting the reaction at a higher temperature, Applicant is proceeding contrary to accepted wisdom by cutting "to a depth of 80–90% of the thickness of the scleral tissue", as is recited in Claim 14.

The Examiner has dismissed Applicant's prior argument on this point by simply stating that Sher's teaching does not "preclude greater depths as being within the scope of the disclosure". Applicants respectfully submit that this is not the standard for determining whether a claimed invention is obvious in view of prior art that teaches away from the claimed invention. In the *Hedges* case, the teachings of Mark did not preclude greater temperatures as being within the scope of the disclosure. Indeed, the prior art in the *Hedges* case acknowledged that operating at elevated temperatures was possible, but produced suboptimal results. Likewise, Sher's disclosure acknowledges that if the incision is made too deep, hemorrhaging may occur. Clearly this is a "teaching away", particularly in view of the fact that Sher refers to it as a "potential complication". Although it may be *possible* to modify Sher's teachings to make deeper incisions, whether a modification is *possible* is not the test for determining whether the modification is obvious. MPEP 2143.01(III). Rather, a motivation to modify must be provided. MPEP 2143. Sher provides the ordinarily-skilled artisan absolutely no motivation to cut deeper, and to the contrary, actually motivates an ordinarily-skilled artisan to not cut deeper. Based on the foregoing, Applicant respectfully submits that Claims 14, 15 and 22 are not obvious in view of the Sher reference. The features of dependent Claims 15 and 22 are believed to be patentable in combination with those of their respective independent claims.

**Claim Rejections Under 35 U.S.C. § 103(a) based on Sher, Schachar and Lin.**

Claims 1–13, 16–21 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sher in view of Schachar and Lin. Claim 1 is independent, and Claims 2–13 depend from Claim 1. Claims 16–21 and 23 depend from independent Claim 14.

Applicant respectfully traverses the Examiner's suggestion that the combination of Sher, Schachar and Lin suggests all of the elements of Claims 1–13, 16–21 and 23. Claims 1–13 recite, among other things, controlling a scanning mechanism “to photoablate the scleral tissue outside the limbus to a depth of 80% to 90% of the thickness of the scleral tissue”. Likewise, by virtue of their dependence on independent Claim 14, Claims 16–21 and 23 recite, among other things, cutting “to a depth of 80% to 90% of the thickness of the scleral tissue”. Neither Lin nor Sher nor Schachar teach these elements, and it would not be obvious to modify Sher to perform the method by cutting to the increased depth of 80% to 90% of the thickness of the scleral tissue, as discussed above with respect to Claim 14. The features of dependent Claims 2–13, 16–21 and 23 are believed to be patentable in combination with those of their respective independent claims.

#### **Conclusion.**

Based on the foregoing, Applicant respectfully submits that Claim 1 is not obvious in view of the combined teachings of Sher, Schachar and Lin, and requests that this rejection be withdrawn. Furthermore, because Claims 2–13 depend from independent Claim 1, Applicant respectfully submits that these claims are allowable for at least the same reasons that Claim 1 is allowable. Likewise, Applicant respectfully submits that Claims 16–21 and 23 are not obvious in view of the combined teachings of Sher, Schachar and Lin, and requests that these rejections also be withdrawn. Finally, as mentioned above, Applicant respectfully submits that it would not be obvious to modify the teachings of Sher to cut “to a depth of 80% to 90% of the thickness of the scleral tissue”, as is recited in Claim 14 and dependent Claims 15 and 22.

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In view of the foregoing comments, Applicant respectfully requests that the Examiner pass the pending claims to allowance.

Respectfully submitted,

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